

## **REMARKS**

By this Amendment, Applicants amend claims 1 and 9, and cancel claims 4 and 12 without prejudice or disclaimer of the subject matter thereof. Claims 1-3, 5-11, 13, and 14 remain currently pending.

In the Office Action, the Examiner rejected claims 1-5 and 7-13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,636,953 to Yuasa et al. ("Yuasa"); and rejected claims 6 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Yuasa in view of U.S. Patent No. 7,165,154 to Coombs et al. ("Coombs").<sup>1</sup>

### **Regarding the rejection under 35 U.S.C. § 102(b)**

Applicants respectfully traverse the rejection of claims 1-5 and 7-13 under 35 U.S.C. § 102(b) as being anticipated by Yuasa.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See M.P.E.P. § 2131, quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1, as amended, recites a combination including, for example,

means for executing a streaming process to  
reproduce a stream of the to-be-reproduced video data  
item . . . while the stream of the to-be-reproduced video data  
item is being received by the communication unit, if it is

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

determined that the to-be-reproduced video data item is stored in the external unit and is the video data item that is moved from the video data recording/reproducing apparatus; and

means for prohibiting execution of the stream process if it is determined that the to-be-reproduced video data item is not the video data item that is moved from the video data recording/reproducing apparatus.

Yuasa fails to disclose at least these features of amended claim 1.

Yuasa discloses “[a] receiving apparatus that sequentially receives and accumulates a plurality of broadcast contents into a storage medium deletes each content accumulated in the storage medium after a predetermined time period as the capacity of the storage medium is limited.” Yuasa, Abstract. “The receiving apparatus 1100 transfers a content to which the user indication to store has been made. . . . The content is then recorded on a storage medium such as a hard disc equipped in the external device. This enables the user to operate the external device to use the transferred content any time, that is, to display or reproduce the content any time.”

Yuasa, column 9, lines 25-33, emphasis added.

However, Yuasa's teaching of operating the external device to display the transferred content arbitrarily does not constitute “executing a streaming process to reproduce a stream of the to-be-reproduced video data item . . . while the stream of the to-be-reproduced video data item [to the video data recording/reproducing apparatus] is being received by the communication unit,” as recited in amended claim 1 (emphasis added). In fact, Yuasa does not specifically describe how the reproduction of a content moved to an external device is controlled.

The Examiner alleges that Yuasa discloses the above listed claim elements by identifying moved and non-moved contents in Figure 4. See Office Action at 4. Applicants respectfully disagree.

According to Figure 4, “[t]he storage target field 2007 shows a device name that identifies an external device into which each content is to be stored. In the storage target field 2007, a device name designated by the user as the storage target is set. . . . The storage state field 2008 shows information as to whether each content has been stored due to the control by the control unit 1140.” Yuasa, column 13, lines 15-24, emphasis added. However, Yuasa at most discloses whether to store or not to store a content. Yuasa’s teaching of merely storing a content selectively in an external device cannot constitute “means for executing a streaming process to reproduce a stream of the to-be-reproduced video data item . . . if it is determined that the to-be-reproduced video data item is stored in the external unit and is the video data item that is moved from the video data recording/reproducing apparatus,” and “means for prohibiting execution of the stream process if it is determined that the to-be-reproduced video data item is not the video data item that is moved from the video data recording/reproducing apparatus,” as recited in amended claim 1 (emphasis added). In fact, Yuasa fails to disclose any concept of executing or prohibiting a stream process “based on the identification information that is added to the to-be-reproduced video data item stored in the external unit,” as recited in amended claim 1.

Therefore, Yuasa fails to disclose each and every claim element of amended claim 1. Yuasa thus cannot anticipate Applicants’ amended claim 1 under § 102(b). Accordingly, Applicants respectfully request withdrawal of the Section 102(b) rejection

of amended claim 1. Because claims 2, 3, 5, 7, and 8 depend from amended claim 1, Applicants also request withdrawal of the Section 102(b) rejection of claims 2, 3, 5, 7, and 8 for at least the same reasons stated above.

Further, amended independent claim 9, while of different scope, includes similar recitations to those of amended claim 1. Amended claim 9 is therefore also allowable for at least the same reasons stated above with respect to amended claim 1. Applicants also request withdrawal of the Section 102(b) rejection of amended claim 9 and of claims 10, 11, and 13, which depend from amended claim 9.

Because claims 4 and 12 have been canceled, the Section 102(b) rejection of claims 4 and 12 is moot.

**Regarding the rejection under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of 6 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Yuasa in view of Coombs, because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness based on a combination or suggestion of prior art, “Office personnel must articulate . . . a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.” M.P.E.P. § 2143.A (8<sup>th</sup> edition, revision 6).

Claim 6 depends from claim 1 and claim 14 depends from claim 9. As set forth above, Yuasa fails to teach or suggest at least “means for executing a streaming process to reproduce a stream of the to-be-reproduced video data item that is

transferred from the external unit while the stream of the to-be-reproduced video data item is being received by the communication unit, if it is determined that the to-be-reproduced video data item is stored in the external unit and is the video data item that is moved from the video data recording/reproducing apparatus; and means for prohibiting execution of the streaming process if it is determined that the to-be-reproduced video data item is not the video data item that is moved from the video data recording/reproducing apparatus,” as recited in amended claim 1 and required by claim 6, and “executing a streaming process to reproduce a stream of the to-be-reproduced video data item while the stream of the to-be-reproduced video data item is being received from the external unit, if it is determined that the to-be-reproduced video data item is stored in the external unit and is the video data item that is moved from the video data recording/reproducing apparatus; and prohibiting execution of the streaming process if it is determined that the to-be-reproduced video data item is not the video data item that is moved from the video data recording/reproducing apparatus,” as recited in amended claim 9 and required by claim 14 (emphasis added).

Coombs fails to cure the deficiencies of Yuasa. The Examiner alleges that “Coombs et al teaches copying video data item with attributes, which correspond to a specified condition for backup, to the external unit by communication between the communication unit and the external unit, on the basis of attributes of the plurality of video data items stored in the data storage unit (see column 2, lines 11-16).” (Office Action at 6.) Applicants respectfully disagree.

However, even assuming the Examiner's allegation is correct, which Applicants do not concede, Coombs fails to teach or suggest at least the above listed claim elements as recited in claims 1 and 9 and required by claims 6 and 14, respectively.

In fact, Coombs at most teaches a function of backing up the files of a computer system to an external device. See Coombs, Abstract. Coombs determines backup timing or sequence on the basis of the attribute of a file (determines when a file is backed up). See Coombs, column 2, lines 8-24. However, Coombs fails to teach or suggest at least the above listed claim elements as recited in claims 1 and 9, for example, "executing . . . , if it is determined that the to-be-reproduced video data item is stored in the external unit and is the video data item that is moved from the video data recording/reproducing apparatus; and prohibiting execution . . . if it is determined that the to-be-reproduced video data item is not the video data item that is moved from the video data recording/reproducing apparatus."

Therefore, neither Yuasa nor Coombs, taken alone or in any reasonable combination, teaches or suggests all claim elements required by claims 6 and 14. A *prima facie* case of obvious has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claims 6 and 14.

### **Conclusion**

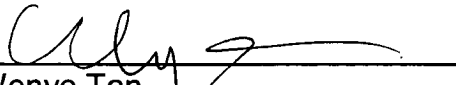
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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